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09/717,147	11/21/2000	Subhash C. Roy	TRA-ONEX-002	1902

7590

12/18/2002

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EXAMINER

NGUYEN, BRIAN D

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,147

Applicant(s)

ROY ET AL.

Examiner

Brian D Nguyen

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment filed 9/16/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 September 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: drawing corrections.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection. Note that a terminal disclaimer was not enclosed in the amendment, filed 9/16/02 as stated by the Applicant.

Claim Objections

2. Claims 1-12 are objected to under 37 CFR 1.75 because of the following informalities:

Claim 1, "requests" in line 5 seems to refer back to "requests" recited in line 4. If it is true, it is suggested to change "requests" in line 5 to ---the requests---. Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, and 9 of copending

Art Unit: 2661

Application No. 09/717,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claimed invention are described in claims 1, 6, 8, and 9 of copending Application No. 09/717,999 with different wording and/or arrangement. Therefore, it is obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gorshe (5,412,651).

Regarding claims 1, Gorshe discloses a method for arbitrating bandwidth in a communication switch comprising generating a repeat data frame having a plurality of rows (see col. 1, lines 44-46); making requests during row N for space in row N+1 (see col. 3, lines 29-37; col. 6, lines 62-68; and Figure 5); and granting requests through an out-of-band link (see lines 531-533 of Figure 5).

Regarding claim 2, Gorshe further discloses each request includes through-the switch routing information and priority level information (see col. 3, lines 61-63).

Art Unit: 2661

Regarding claim 12, Gorshe further discloses the requests are made out-of-band (see lines 531-533 of Figure 5).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Chiussi et al (5,689,506).

Regarding claims 3-4, Gorshe discloses all the claimed subject matter as described in previous paragraph except for the switch is a multistage switch and buffering the request at each stage of the switch. However, multistage switch and buffering the request at each stage of the switch is well known in the art. Chiussi discloses a system using multistage switch and buffering the request at each stage of the switch (see abstract; Figure 11; and col. 3, lines 13-26).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the multistage switch and buffering the request at each stage of the switch as taught by Chiussi in the system of Gorshe so that more switching can be performed by the switch.

9. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Chiussi et al (5,689,506) as applied to claim 1 above, and further in view of Bergantino et al (6,359,891).

Art Unit: 2661

Regarding claims 5-9, Gorshe and Chiussi disclose all the claimed subject matter as described in previous paragraph except for the packet is 52-bytes. However, Bergantino discloses a packet includes 52-bytes rather than 53 bytes (see col. 15, lines 27-28). Therefore, it would have been obvious to a person of ordinary skill in the art to segment each packet larger than 52-bytes into 52 byte chunks as taught by Bergantino in the system of Gorshe in order to meet specific needs.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gorshe (5,412,651) in view of Chow et al (6,148,349).

Regarding claim 11, Gorshe discloses all the claimed subject matter as described in previous paragraph except for the requests are made in-band. However, Chow discloses the use of in-band and out-of-band links for transmission of messages (see col. 26, lines 26-27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use in-band for the requests as taught by Chow in the system of Gorshe since the use of in-band or out-of-band is a matter of design choice.

Allowable Subject Matter

11. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Art Unit: 2661

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (703) 305-5133.

The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on (703) 305-4703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

BN
December 14, 2002

A handwritten signature in black ink, appearing to read 'Brian Nguyen', written in a cursive style.

Brian Nguyen